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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,854	01/11/2005	John Alan Gervais	PU020335	2672
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Joseph J. Laks			EXAMINER	
Thomson Licensing LLC			KIM, TAE K	
2 Independence Way, Patent Operations				
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PRINCETON, NJ 08543			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,854

Applicant(s)

GERVAIS ET AL.

Examiner

TAE K. KIM

Art Unit

2153

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5-10, 15, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 11-14, 16-18, and 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to the Applicant's Request for Continued Examination (RCE) filed on April 14, 2008. Claims 3, 5 – 10, 15, 19, and 20 have been cancelled by the Applicant. Applicant has added new Claims 22 – 31. Claims 1, 2, 4, 11 – 14, 16 – 18, and 21 – 31, where Claims 1 and 16 are in independent form, are presented for examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 14, 2008 has been entered.

Claim Objections

With regards to the objection to Claim 20, Applicant has cancelled the claim. The Examiner had withdrawn the objection.

Claim 23, 25, 29, and 31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 23, 25, 29, and 31 do not further limit Claims 22, 24, 28, and 30, respectively, since the

limitations stated are found within independent Claims 1 and 16, which the latter claims depend on and incorporate.

Response to Arguments

Applicant's arguments with respect to Claims 1, 2, 4, 11 – 14, 16 – 18 and 21 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant amendments.

Claim Rejections - 35 USC § 112

Claims 24, 25, 30, and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation that "a value of the particular one compatibility parameter of said ALG file is added to a value of another particular one compatibility parameter of said ALG file as a sum that is compared to a value of the compatibility feature of said bi-directional communications device" was not previously disclosed. Claims 25 and 31, which are dependent on Claims 24 and 30, respectively, are also rejected under 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 4, 11, 12, 14, 16 – 18, and 21 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,986,133 B2, invented by Michael

D. O'Brien et al. (hereinafter "O'Brien"), in view of U.S. Appl. 2002/0152399, filed by Gregory J. Smith (hereinafter "Smith").

1. Regarding Claims 1, 4, 14, 16, and 27, O'Brien discloses a system and method of receiving, at a bi-directional communications device [Fig. 2; Col. 6, Lines 34-55; agent fetches file from the server], an application level gateway (ALG) file [Fig. 1; Col. 4, Lines 22-25; bi-directional device can be another server or any other interconnect system, also called a gateway];

comparing, at the bi-directional communications device, a particular one compatibility parameter of said ALG file with a compatibility feature of said bi-directional communications device [Col. 5, Lines 55-58; Col. 12; Lines 48-54; upgrade policy defining which IP address or hostname of the server will provide updates and the "serverName" component parameter specifying the IP address or host name of the server the agent will inquire about the update]; and

storing said ALG file at said bi-directional communications device in response to a favorable comparison of said at least one compatibility parameter [Col. 5, Lines 55-58; Col. 12; Lines 48-54; if the "serverName" component parameter matches the IP address or hostname of the server carrying the particular updates match, the upgrade process will start and the agent will download the upgrade].

O'Brien does not specifically disclose that the particular one compatibility parameter of the file is also compared with a non-signature, non-code-error checking feature expected in received and authentic files.

Smith discloses of a method and system for providing protection from exploits to devices connected to a network by comparing the received file with a non-signature, non-code-error checking feature expected in received and authentic files [Para. 0065 and 0066; the size of the header or body of the file is examined to determine if they are longer then they should be]. It would have been obvious to one skilled in the art at the time of the invention to verify the header or body length of a particular message to ensure that there is no executable code within the overflow buffers allotted for portions or all of a header or body of a file [Para. 0026]. This allows the system to prevent improper access to data or unauthorized programs executed on the host computer [Para. 0026].

2. Regarding Claims 2 and 17, O'Brien, in view of Smith, discloses all the limitations of Claims 1 and 16 above. O'Brien further discloses of rejecting the ALG file at the communications device in response to an unfavorable comparison of said particular one compatibility parameter [Col. 5, Lines 27-30, 32-34; upgrade policies allow system administrators to determine which target devices will or will not receive a specific upgrade].

3. Regarding Claims 11 and 18, O'Brien, in view of Tate, discloses all the limitations of Claims 1 and 16 above. O'Brien discloses several types of bi-directional devices that can implement the disclosed system and method [Fig. 1; Col. 4, Lines 23-26; devices can be a monitor, printer, copier, cell phone, PDA, server, etc.]. However, O'Brien or Smith does not specifically disclose that the bi-directional communication device is a cable modem.

Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, i.e. cable modem is a bi-directional communication device, are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

4. Regarding Claim 12, O'Brien, in view of Smith, discloses all the limitations of Claim 1 above. O'Brien further discloses that the system periodically polls a service provider to determine if at least one of a new and updated ALG file is available, then sends a request for an available ALG file and receives said requested ALG file from an access network [Col. 4, Lines 28-30, 56-59; agent polls the server for updates and, if an update is available, fetches and applies the update to the device].

5. Regarding Claims 21 – 23, 26, 28, 29, O'Brien, in view of Smith, discloses all the limitations of Claims 1, 4, 16, and 27 above. O'Brien further discloses that at least one compatibility feature of said bi-directional communications device comprises an amount of available memory in said bi-directional communications device to store the ALG file [Fig. 2; Col. 7, Lines 15-21; upgrade agent in the firewall fetches all chunks of the upgrade file and rebuilds the file before the agent performs a security check; Col. 10, Line 33 - Col. 11, Line 59; the InMemCapacity parameter requires that the bi-directional

device has at least this amount of memory available to fetch all chunks of the upgrade and to rebuild the file].

6. Regarding Claims 24, 25, 30, and 31, O'Brien, in view of Smith, discloses all the limitations of Claims 1 and 16 above. O'Brien further discloses that a value of the particular one compatibility parameter of said ALG file is added to a value of another particular one compatibility parameter of said ALG file as a sum that is compared to a value of the compatibility feature of said bi-directional communications device [Col. 7, Lines 15-18; the upgrade agent performs a comparison for each chunk of the upgrade with the appropriate checksum to determine if the file is corrupt].

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien, in view of Smith, and further in view of U.S. Patent 6,031,830, invented by Paul A. Cowen (hereinafter referenced as "Cowen").

7. Regarding Claim 13, O'Brien, in view of Smith, discloses all the limitations of Claim 1 as stated above. O'Brien or Smith, however, do not specifically disclose that the request to download the files occurs after a configuration file is identifying at least one new or updated ALG file is received and first compared by the device.

Cowan discloses a system and method of downloading new or updated files where the device receives a configuration file from said service provider, which identifies at least one new or updated ALG files, then the devices sends a request for those files, and receives the requested files from an access network (Figs. 7(a) – (h); Col. 10, Lines 27 – Col. 11, Line 54; terminal requests query to host/server, which in turn sends a package definition packet identifying the file; terminal then compares

versions and if they are different, terminal transmits the file request packet and the host/server begins transmitting file data). It would be obvious to one skilled in the art at the time of the invention to verify that the files are new or updated before downloading them into the terminal. Not only will that save resources that would have been used if the files are downloaded and then verified, but it also prevents the terminal from accidentally deleting the prior version of the files prior to completing the download of the new or updated files.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,842,906 – system and method that uses an application proxy that manages and checks if the user actions are allowed prior to performing such requests.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae K. Kim, whose telephone number is (571) 270-1979. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess, can be reached on (571) 272-3949. The fax phone number for submitting all Official communications is (703) 872-9306. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the examiner at (571) 270-2979.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Tae K. Kim/

/THUHA T. NGUYEN/
Primary Examiner, Art Unit 2153